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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GIANFRANCO D'AMATO

Appeal 2008-001264
Application 10/630,378
Technology Center 3700

Before WILLIAM F. PATE, III, MICHAEL W. O'NEILL, and
KEN B. BARRETT, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Gianfranco D'Amato (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 2, 4-10, 12-20, 22-27, and 29-35. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The claimed invention is to a collapsible container for receiving food.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. Collapsible container for receiving food, having a flexible wall comprising at least two transparent layers, the container comprising a withdrawal opening with a bent opening edge and being closed at its end opposite the withdrawal opening, the container being rolled from a two-dimensional blank which is connected with itself in an overlap region extending in the longitudinal direction of the container by at least one of heat and pressure, wherein the container is formed from a transparent and fluid tight material which can be shaped for bending the opening edge and is dimensionally stable after the shaping, and wherein the container and the material are stable at least within the temperature range of -50°C to +120°C.

The Prior Art

The Examiner relies upon the following as evidence of unpatentability:

Beall	US 4,324,338	Apr. 13, 1982
Halligan	US 4,574,987	Mar. 11, 1986
Summons	US 4,863,014	Sep. 5, 1989
McLaughlin	US 6,210,766 B1	Apr. 3, 2001
Sekine ²	JP 56-156777	Nov. 21, 1981

² Both the Examiner and Appellant have identified this piece of prior art as JP '777.

*The Rejections*³

The following Examiner's rejections are before us for review:

Claims 1, 2, 4-10, 12-20, 22-27, 30, 31, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekine in view of McLaughlin and Summons.

Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekine, McLaughlin and Summons, as applied to claim 1, and further in view of Halligan.

Claim 34 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekine, McLaughlin, and Summons, and Beall.

Claim 35 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekine, McLaughlin, Summons, and Beall, as applied to claim 34, and further in view of Halligan.

The Examiner's positions concerning each rejection *supra* can be found on pages 4 though 8 of the Supplemental Answer. The Examiner's responses to Appellant's contentions can be found on pages 9 through 14 of the Supplemental Answer.

Contentions

Appellant separately argues the patentability of claims 1, 2, 5, 6, 25, 26, 30, 32, 34, and 35. App. Br., *passim*.

Appellant acknowledges that claims 3, 4, 7-10, 12-20, 22-24, 27, 31, and 33 will stand or fall with claim 1. App. Br. 7.

³ The Examiner submitted a Supplemental Answer correcting an error concerning the rejection of claim 29. Claim 29 was canceled by Appellant during prosecution of the patent application.

SUMMARY OF DECISION

We AFFIRM-IN-PART.

DISCUSSION

Obviousness based on Sekine, McLaughlin, and Summons

Claim 1

Appellant's arguments appear premised on "dimensional stability" meaning that at least one of the container and the material has a resilient aspect. However, the term "dimensional stability" cannot be as narrowly construed as Appellant would desire when this term is read in light of the Specification. Appellant fails to direct attention to any portion of the Specification that supports the allegation that the term "dimensional stability" denotes resiliency. The Specification discloses that "dimensional stability" is "always to be understood to the effect that the wall is still flexible enough for moving the food towards the withdrawal opening by exerting an external pressure on the collapsible container." Spec. 6, para. [0017]. As such, the understanding of "dimensional stability" does not necessarily have a factor of resiliency when compared to other portions of the Specification. *See* Spec. 20, para. [0079] ("[T]he container is elastic, so that it takes on its original shape even after having been pressed.")

In our view, "dimensional stability," when read in light of the Specification, is broadly understood to mean that the container or its material have the capability of maintaining its shape after shaping or assembly, during packaging and transport, and/or while dispensing; and not necessarily having a resilient aspect associated with the container or the material.

Given the above claim construction for the term “dimensional stability” and Appellant’s admission that Sekine’s container is “presumably stable,” *see* App. Br. 9, we find that Sekine has a “dimensional stability” quality and thus satisfies the claimed “dimensional stability” feature recited in claim 1.

Responding to Appellant’s concerns that no motivation exists to apply the teachings of the two collapsible containers within McLaughlin and Summons to Sekine, it appears that Appellant is arguing a person of skill in the art would not bodily incorporate the teachings of McLaughlin and Summons into Sekine. However, “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). *See also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) (“Combining the *teachings* of references does not involve an ability to combine their specific structures.”). Given this legal authority, Appellant’s argument is unconvincing to show a person of ordinary skill in the art would not have reason to combine the teachings of McLaughlin and Summons with the disclosure of Sekine. Moreover, the Examiner explained to Appellant that the Examiner was utilizing the disclosures within McLaughlin and Summons to teach the use of multi-layer plastic laminate material and multiple transparent layers. Ans. 9. As such, the Examiner was not trying to bodily incorporate the entire structures of McLaughlin and Summons into Sekine.

Instead, the Examiner was applying the teachings of McLaughlin's multiple layer laminate and Summons's multiple transparent layers, as shown in collapsible containers, to the container disclosed in Sekine. Further, responding to Appellant's concerns that motivation is lacking, the Supreme Court, in *KSR*, explained that motivation is not the only valid reason for combining the teachings of the prior art to render a claimed invention obvious.

Appellant's arguments that the combined teachings fail to disclose, teach, or suggest a transparent and fluid tight material, a container that is stable within the entirety of the claimed range, and a withdrawal opening with "a bent opening edge" as recited in claim 1, are unconvincing. All of the containers disclosed appear to be fluid tight, while at least Summons is transparent. Sekine discloses an opened section peripheral edge or lip around the withdrawal opening. *See* fig. 4, reference numeral 4. Contrary to Appellant's understanding of Sekine, and Appellant providing no rebuttal evidence to support Appellant's understanding, in our view, a person of ordinary skill in the art would understand the structure identified in Sekine as the "opened section periphery" to satisfy a claim feature directed to "a bent opening edge" since Sekine's figures appear to show the disclosed invention in sequential fabrication steps. Figure 1 depicts the blank, Figures 2 and 3 depict the assembly process, and Figure 4 shows complete construction. It is at the stage depicted in Figure 4 where the bent edge appears and yet is absent from Figures 2 and 3.

Concerning the argument that the prior art fails to disclose a container that is stable within the claimed temperature range, we disagree, since the claimed range is for containers containing items that are ingested by

humans, and at least McLaughlin discloses an item in its container that is partially ingested by humans during use of the item within the container, *viz.*, teeth brushing as evidenced by the assignee and depiction of a toothpaste tube in the figures.

For the reasons given above, the Examiner's rejection of claim 1 as obvious over Sekine, McLaughlin, and Summons is sustained.

Claims 3, 4, 7-10, 12-20, 22-24, 27, 31, and 33

The Examiner's rejection of these claims is sustained for the same reasoning as applied to claim 1 since Appellant did not separately argue these claims.

Claim 2

Based on the Examiner's findings and analysis provided for this combination of prior art, we are constrained to reverse the rejection of claim 2, because the Examiner fails to adequately explain how the combined teachings of Sekine, McLaughlin, and Summons would have a transparency aspect that enables the filling of the container to be monitored as called for in claim 2. While we agree with the Examiner that McLaughlin inherently teaches the outer layer being transparent, otherwise, the holographic film layer below it would be superfluous, there is neither evidence nor cogent reasoning to find that McLaughlin's inner layers, the layers on the other side of the holographic film layer and the layers that line the interior volume are also transparent. The flaw with the Examiner's proposed modification applying Summons' transparent layers to the McLaughlin layers is that the Examiner assumes the holographic layer partially overlays the outer transparent layer and thus any other layers. However, McLaughlin's disclosure fails to provide any express or inherent teachings that the

holographic film layer could partially overlay the outer, inherently transparent, layer or the two inner layers. Moreover, McLaughlin contains an express teaching that the holographic layer is coterminous with the other layers that construct the container, *see* figs. 1 and 2. This express disclosure tends to refute a teaching that a person of ordinary skill in the art could modify McLaughlin's holographic film to have it not be coterminous with the other film layers and then further modify the inner layers of McLaughlin to be transparent in order to enable a monitoring of the filling of the container.

Claim 5

We are constrained to reverse the Examiner's rejection of claim 5 as the Examiner's findings and analysis are flawed in providing a reasoning with some rational underpinnings, other than viewing Appellant's Specification and claims, that a person of ordinary skill in the art would combine the teachings as the Examiner has set forth in the rejection. There appears to be no reason with some rational underpinning to modify McLaughlin's inner layers to be transparent since the holographic film layer is disclosed as being coterminous with the other layers, and thus the film layer would block any visibility of the inner layers. Accordingly, the Examiner's rejection appears to be born out of improper hindsight reconstruction for rendering obvious the claimed container having three transparent layers given the teachings of Sekine, McLaughlin, and Summons.

Claim 6

Appellant's arguments against the rejection of claim 6 fail to convince us that the Examiner erred in rejecting the claim based on the teachings of

Sekine, McLaughlin, and Summons. Appellant surmises the rejection is flawed because Summons discloses an elastic central layer, but the layer is not dimensionally stable. As essentially explained by the Examiner, a person of ordinary skill is a person of ordinary creativity and not an automaton, and, *arguendo* Summons' central elastic layer is not dimensionally stable, when the teachings of Summons that are directed to having a central elastic layer in a container are combined with Sekine and McLaughlin, the combination of laminate of layers would remain "dimensionally stable" as Appellant has broadly used the term in Appellant's Specification. As such, the Examiner's rejection of claim 6 is sustained.

Claim 25 and 26

We are constrained to reverse the Examiner's rejection of claims 25 and 26 for essentially the same reasoning as applied to claim 5. These rejections are founded on a flawed understanding that McLaughlin contains an express or inherent teaching that the holographic film layer could be non-coterminous with the other layers and thus any other layer below the holographic layer would be visible from viewing it through the outer, inherently transparent, layer. Moreover, we agree with Appellant that having the print being visible only after part of the food is removed is not a result effect variable as the Examiner finds.

Claim 30

While argued separately, Appellant is relying on the argument that the resultant combined teachings of Sekine, McLaughlin, and Summons would not yield a transparent container that is dimensionally stable. Based on this reasoning, Appellant contends the combined teachings would not be capable

of being both stacked and unstacked. App. Br. 12. Inasmuch as Appellant's arguments are unconvincing to show that the combined teachings of Sekine, McLaughlin, and Summons do not render obvious a container having transparent and elastic aspects along with being "dimensionally stable" as broadly used in the Specification, these contentions are likewise unconvincing to show that the resultant container would not be capable of being both stacked and unstacked. Moreover, as the Examiner rationalizes, the container formed from the combined teachings of Sekine, McLaughlin, and Summons would have a taper and thus would be readily capable of being stacked one on top of the other when empty in any orientation. Based on the foregoing, we sustain the Examiner's rejection of claim 30.

Claim 32

Appellant's arguments fail to convince us that combining the teachings of Sekine, McLaughlin, and Summons with Halligan's teaching of the air gap between two layers in a container for insulation would be nothing more than combining familiar elements according to known methods and does no more than yield a predictable result of providing an air gap between the layers in a container for insulation purposes. As such, we sustain the Examiner's rejection of claim 30.

Claim 34

We are constrained to reverse the Examiner's rejection of claim 34 for essentially the same reasoning concerning claim 5. Based on this record, no reason with rational underpinnings appears present to have three transparent layers when one of the references, McLaughlin, teaches that an opaque layer, the holographic film, is coterminous with the other layers.

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DECISION

The Examiner's decision to reject claims 1, 3, 4, 6-10, 12-20, 22-24, 27, and 30-33 as obvious is affirmed.

The Examiner's decision to reject claims 2, 5, 25, 26, and 34 as obvious is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

mls

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